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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,767	06/28/2001	Moshe Weiner	Q63327	3418

7590

05/06/2003

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EXAMINER

FLETCHER, MARLON T

ART UNIT PAPER NUMBER

2837

DATE MAILED: 05/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/892,767

Applicant(s)

WEINER ET AL.

Examiner

Marlon T Fletcher

Art Unit

2837

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 February 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1-13, 15, 18, 20-25, 27, 30, 31, and 33-39, are rejected under 35 U.S.C. 102(e) as being anticipated by Catona (6,288,319).

As recited in claims 1, 20 and 25, Catona discloses a tele-karaoke system for performing karaoke comprising: a tele-karaoke server (18) storing a plurality of songs in karaoke format; a user interface (12) allowing a user to select a song in karaoke format from said tele-karaoke server in order to perform the song as a karaoke performance; and an MMS multimedia messaging server (20) recording the karaoke performance as an MMS message (figure 3).

As recited in claims 2, 8, 13, 21, 24, 30, 34, and 36, Catona discloses the tele-karaoke system, wherein the MMS multimedia messaging server allows the user to send the recorded performance as an MMS message to another as discussed in column 3, lines 42-45.

As recited in claims 3, 9, 22, and 37, Catona discloses the tele-karaoke system, wherein the MMS multimedia messaging server allows the user to edit the recorded karaoke performance as discussed in column 2, lines 47-49 and column 3, lines 7-20.

As recited in claims 4, 10, 31, and 38, Catona discloses the tele-karaoke system, wherein the MMS multimedia messaging server allows the user to listen to the recorded karaoke performance as discussed in column 3, lines 1-2.

As recited in claims 5, 11, 23, 33, 35, and 39, Catona discloses the tele-karaoke system, wherein the MMS multimedia messaging server allows the user to store the recorded karaoke performance via storage (20).

As recited in claims 6 and 12, Catona discloses the tele-karaoke system, wherein said MMS multimedia messaging server includes customer storage space to store recorded performances of the user via storage (20).

As recited in claim 7, Catona discloses the tele-karaoke system, further comprising a tele-karaoke service provider coupled to the user interface and the tele-karaoke server to regulate user interaction and retrieve songs from the tele-karaoke server as seen in figure 2.

As recited in claims 15, 18, and 27, Catona discloses the tele-karaoke system, wherein the user interface is a personal computer (12).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 14, 16, 19, 20, 26, 28, 29, are rejected under 35 U.S.C. 103(a) as being unpatentable over Catona in view of Lewis (5,564,001).

Catona is discussed above. Catona does not disclose a telephone as the interface to the system.

However, as discussed in claim 14, 20 and 29, Lewis discloses a tele-karaoke system, wherein the user interface is a cellular telephone as discussed in the abstract.

As recited in claims 16, 19, 26, and 28, the tele-karaoke system, wherein the user interface is a fixed telephone as seen in figure 2A.

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the teachings of Lewis with the apparatus of Catona, because Lewis provides an alternate interface for use of the multimedia system.

5. Claims 17, 32, and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Catona.

Catona is discussed above. Catona does not disclose editing text and video.

However, as recited in claims 17, 32, and 40-42 Liu discloses a tele-karaoke system, wherein the user edits the recorded message by adding at least one of text (102) and video (96).

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the teachings of Liu with the apparatus of Catona, because Liu provides the addition of video and text editing to provide the lyrics for the user.

### ***Response to Arguments***

6. Applicant's arguments filed 02/21/2003 have been fully considered but they are not persuasive.

The applicant argues that Catona fails to disclose MMS server that records a karaoke performance. However, a karaoke performance is merely a performance of a sing-along, wherein a pre-recorded song is played and a person sings along with the pre-recorded song. Catona provides this element and further discloses recording this performance as seen in figure 3, wherein the recording can be stored in a server or database. For this reason, the examiner disagrees with the applicant's argument.

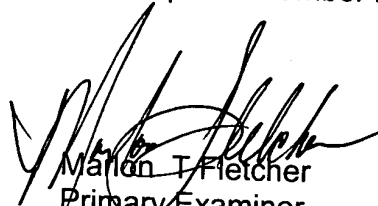
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marlon T Fletcher whose telephone number is 703-308-0848. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Nappi can be reached on 703-308-3370. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

  
Marion T. Fletcher  
Primary Examiner  
Art Unit 2837

  
MTF

May 5, 2003